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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,911	09/24/2003	William James Back	BAC 0007 PA/40072.12	8194
7590	04/04/2005		EXAMINER	
DINSMORE & SHOHL LLP Suite 500 One Dayton Centre Dayton, OH 45402-2023			STORMER, RUSSELL D	
			ART UNIT	PAPER NUMBER
			3617	

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/669,911	BACK, WILLIAM JAMES	
	Examiner Russell D. Stormer	Art Unit 3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 January 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 3-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 3-21 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4, 5, 6, 7, 8, 13, 15, 16, 17, 19, 20, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by MacBeth.

As shown in figures 6-8, 14, 18-21, 23, and 24, MacBeth discloses a wheel assembly comprising an outer rim or hub **B**, a pair of spacers or discs **A** having an outer edge **A**¹ which is received in a groove or recess in the outer hub (or rim) and further supported on the hub **C**² (figure 1) in grooves formed therein. The discs would be removable by reversing the assembly process described in the patent. Note lines 66-72 of page 2. The spacers could be interchanged.

With respect to claims 4, 5, 19, and 20, the cutouts are shown in figure 2 and are considered to be decorative inasmuch as they form a snowflake design.

With respect to claims 7 and 17, note that the outer hub (rim) shown in figure 22 shows the disc members received in recesses formed in the inner surface of the outer hub.

The tire or outer polymeric layer or tire is shown in figures 6-8, 14, 18-21, 23, 24, and 30, but is not identified by a reference character. However, due to the construction of the tire and the rim, it is clear that this tire is vulcanized to the rim in the manner which was well-known at the time of MacBeth.

The wheel is not disclosed as being for a skate, however this is considered to be an intended use of the wheel and is given no patentable weight because no structure has been claimed which would put the skate wheel into a particular environment, and also because all of the structural limitations have been met.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3, 10, 11, 12, 14, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacBeth.

MacBeth is meets the limitations of claims 1 and 15 as set forth in paragraph 2 above.

For the spacers to define a generally flat front surface would have been obvious as a design expedient as such a feature would not affect the function of the wheel.

For the inner and outer hubs to comprise aluminum would have been obvious to those of ordinary skill in the art in order to reduce the weight of the wheel.

For the spacers to be comprised of aluminum, titanium, or plastic would have been obvious to those of ordinary skill in the art to reduce the weight of the wheel.

For the spacers to have a decorative colored finish would have been obvious as such finished have long been used in the art.

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over MacBeth in view of Wahlberg (newly cited).

The wheel of MacBeth is shown to be mounted on an axle, but bearings are not shown.

Wahlberg teaches a disc wheel assembly in which a disc is mounted to a hub 3. The hub has recessed areas which receive roller bearings 4. From this teaching it would have been obvious to for the hub of MacBeth to include recessed areas to receive roller bearings in order to allow the hub to be mounted on an axle which includes bearings as the use of bearings is well-known in the art and would allow the wheel to turn more efficiently around the axle.

Response to Arguments

6. Applicant's arguments filed January 14, 2005 have been fully considered but they are not persuasive.

Applicant's arguments that MacBeth is not directed towards a skate wheel are noted. However MacBeth meets all of the structural limitations of the specified claims and therefore the intended use of the wheel is afforded no patentable weight.

Applicant argues that the wheel of MacBeth does not teach decorative spacers that are easily removed and interchanged, and that the spacers are not removed by *snapping or popping*, but these features are not claimed. Further, the discs may be removed as noted in line 66-72 of page 2 of MacBeth, and the term "decorative" is not really definite and any shape or design could be considered to be decorative.

MacBeth does teach the use of a polymeric tire which would inherently be bonded to the rim or outer hub as was well-known at the time. See the newly cited patents to Robb and Kranz, and the previously cited patent to Guernsey for examples of this structure.

It is felt that the structures A^0 in the inner hub, and B^1 , B^2 , and B^x in the rim of MacBeth shows recesses or grooves which receive the discs.

As for the claimed materials, any known and suitable material could be used for the hubs and the spacers. Those of ordinary skill in the art could readily choose the materials based on the intended use of the wheel, the desired cost, the appearance, the desired weight and strength, etc.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The references show other wheels having tires bonded thereto or hubs which have recesses to receive bearings.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell D. Stormer whose telephone number is (703) 308-3768. (After April 11, 2005 the Examiner can be reached at (571) 272-6687.) The examiner can normally be reached on Monday through Friday, 9 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joe Morano can be reached on (703) 308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

3/29/05


RUSSELL D. STORMER 3/29/05
PRIMARY EXAMINER 